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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,347	10/26/2001	Steven T. Breidenbach	10010026 -1	2380

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EXAMINER

PILLAI, NAMITHA

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/046,347

Applicant(s)

BREIDENBACH ET AL.

Examiner

Namitha Pillai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8-11 and 24-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6, 8-11 and 24-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Appeal Brief

1. The Examiner acknowledges Applicant's submission on 5/22/06. Arguments concerning claims 24-28 and 30-42 are persuasive concerning the searching and identifying of the peripheral devices. Prosecution has been re-opened. Claims 1, 3-6, 8-11 and 24-42 have been rejected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3, 5-6 and 8-11 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U. S. Patent No. 6,452,95 B1 (Casey et al.), herein referred to as Casey.

Referring to claim 1, Casey discloses a system for improving the performance of a plurality of peripheral devices (column 1, lines 7-9). Casey discloses a first peripheral device comprising a first software component and having a first functionality (column 2, lines 58-61 and column 3, lines 3-4). Casey also discloses a second peripheral device comprising a second software component and having a second functionality, the second peripheral device being coupled to the first peripheral device (column 2, lines 61-67 and column 3, lines 1-5). Casey discloses that the first and second peripheral devices

together perform a third functionality in addition to the first and second functionalities and having a common user interface (column 3, lines 34-39). Casey further discloses no intermediate computing device positioned along the communication path between the peripheral devices (column 5, lines 16-21). Casey discloses a teaching wherein the first peripheral device would include the display on which would be presented a graphical user interface such as a control panel that would present the third functionality of a digital copier to a user for selection (column 4, lines 1-5).

Referring to claim 3, Casey discloses that the first and second peripheral devices are coupled via a network (column 1, lines 46-48).

Referring to claim 5, Casey discloses that the first and second peripheral devices are coupled directly to each other (column 5, lines 16-20).

Referring to claim 6, Casey discloses that the first peripheral device is a scanner and the second peripheral device is a printer and the third functionality is a copying functionality (column 1, lines 9-13).

Referring to claim 8, Casey discloses first software component of the first peripheral device and the second software component of the second peripheral device allow the first and second peripheral devices to exchange information over a network, pertaining to the identity of the first peripheral device and the second peripheral device (column 3, lines 3-8).

Referring to claim 9, Casey discloses that the information exchanged between the first and second peripheral devices further comprises information relating to the

capabilities of the first peripheral device and the second peripheral device (column 5, lines 61-67 and column 6, lines 1-6).

Referring to claim 10, Casey discloses that the first peripheral device modifies its capabilities based on the information received from the second peripheral device (column 6, lines 44-50), wherein the printer modifies its capabilities based on the image input device's capabilities.

Referring to claim 11, Casey discloses that the first peripheral device presents to a user with a graphical user interface a menu of available functionality based on the information received from the second peripheral device (column 3, lines 34-39), wherein the control panel displays a menu based on functionality that is representative of both peripheral devices.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Casey and "Wireless Networks".

Referring to claim 4, Casey does not specifically disclose that the first and second peripheral devices are coupled via a wireless network. It would have been obvious for one skilled in the art at the time of the invention to implement a wireless network through which the devices are coupled. Wireless networks have been a

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growing trend in the field, wherein networks that are existing such as the Internet, as disclosed in Casey and which may previously have been connected via cables have been introduced to wireless networks wherein all connectivity would be wireless.

"Wireless Networks" teaches the advantages of having a wireless network and the features of network that are wireless (page 1, lines 12-15). It would have been obvious for one skilled in the art at the time of the invention to learn from the "Wireless Network" to implement a means wherein a network would be wireless.

4. Claims 24-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casey and U. S. Patent No. 6, 789, 111 B1 (Brockway et al.), herein referred to as Brockway.

Referring to claims 24 and 32, Casey discloses a method practiced by a personal computer (PC) for providing additional functionality from peripheral devices (column 1, lines 7-13). Casey discloses presenting to the user with the PC a functionality that is available through combination of the capabilities of the identified peripheral devices, the functionality being a functionality that is not independently provided by the identified peripheral devices (column 3, lines 14-20). Casey discloses a system with peripheral devices but does not clearly disclose searching and identifying, and determining the capabilities of these peripheral devices in a PC. Brockway clearly discloses the automatic detection, including searching and identifying peripheral devices connected to a computer, further determining the capabilities of each identified peripheral device using the PC, determining the capabilities including identifying components of the device and accessing driver information based on the capabilities (column 2, lines 16-

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24). It would have been obvious to one skilled in the art, at the time of the invention to learn from Brockway to search and identify peripheral devices and determine the capabilities of each identified device using a PC. Casey is a system that involves the connection of peripheral devices to a computer system. Brockway teaches that searching and identifying of peripheral devices is needed in systems with devices attached to a system, where the search and identification process would alleviate the user from having to manually install any new devices (column 1, lines 31-45).

Therefore, one skilled in the art at the time of the invention would have been motivated to learn from Brockway to search and identify peripheral devices and determine the capabilities of each identified device using a PC.

Referring to claims 25 and 33, Casey and Brockway disclose automatically querying all peripheral devices on a network to which the PC is connected (Brockway, column 2, lines 63-67).

Referring to claim 26, Casey and Brockway discloses determining the capabilities of the identified peripheral devices further comprises receiving information from peripheral device software provided on each identified peripheral device (Casey, column 4, lines 38-48 and Brockway, column 2, lines 54-60).

Referring to claims 27 and 34, Casey and Brockway disclose storing information about the peripheral device capabilities in a registry of the PC (column 3, lines 35-40).

Referring to claims 28 and 35, Casey discloses presenting functionality to the user comprises presenting the functionality to the user with a graphical user interface (GUI) on a display associated with the PC (Figure 2 and column 3, lines 34-39).

Referring to claim 29, Casey and Brockway disclose that the GUI comprises a menu (Casey, Figure 2), but does not explicitly show that the menu is a pull-down menu. It would have been obvious for one skilled in the art, at the time of the invention to display a pull-down menu. Casey clearly displays a menu, wherein a pull-down menu is simply a type of menu that is displayed for listing items to be selected by the user. As is well known the field of graphical user interfaces, various types of menus can be displayed for selection including the listed items menu as shown in Figure 2 of Casey and the pull-down menu. The Examiner takes Official Notice wherein it is a well-known feature that a pull-down menu can be displayed containing much of the components as shown in the control panel of Figure 2. It is well known in the field of graphical user interfaces, at the time of the invention, that a pull-down menu can be displayed and used for selection of various items.

Referring to claims 30 and 36, Casey discloses that the GUI displays the complete set of tasks that can be performed through combination of the capabilities of the identified peripheral devices (column 3, lines 34-39).

Referring to claims 31 and 37, Casey discloses presenting functionality to the user comprises presenting a copying functionality that is available due to a scanning capability of a scanner and a printing capability of a printer (column 6, lines 7-13).

Referring to claim 38, Casey discloses a peripheral device with capabilities to automatically present a functionality option to a user that is only available through combination of the capabilities of the peripheral device and at least one of the compatible peripheral devices (column 3, lines 14-21). Casey does not clearly disclose

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auto recognition logic with the components disclosed in claim 38. Brockway discloses an auto recognition logic (column 4, lines 58-62), that transmits a messages announcing the presence of a peripheral device, this announcing and transmitting of messages between client and server machines teaching transmitting broadcast messages on a network to announce the presence of the peripheral device on the network (column 3, lines 20-25). Brockway discloses receiving transmitted response signals from the devices and the client connected to the device, all on the network, with information identifying and the capabilities of the peripheral devices (column 6, lines 5-12). It would have been obvious to one skilled in the art, at the time of the invention to learn from Brockway to use auto recognition logic to announce the presence of peripheral devices on a network and to communicate information about the capabilities and identification of the peripheral devices. Casey is a system that involves the connection of peripheral devices to a computer system. Brockway teaches that searching and identifying of peripheral devices is needed in systems with devices attached to a system, where the automatic recognition process would alleviate the user from having to manually install any new devices (column 1, lines 31-45). Therefore, one skilled in the art at the time of the invention would have been motivated to learn from Brockway to implement auto recognition logic to announce the presence of peripheral devices on a network and to communicate information about the capabilities and identification of the peripheral devices.

Referring to claim 39, Casey and Brockway disclose that the auto-recognition logic comprises a software component that is configured to modify a capability of the

peripheral device based upon the information received from the compatible peripheral devices (Casey, column 3, lines 3-12).

Referring to claim 40, Casey and Brockway disclose that the auto-recognition logic presents the functionality option to the user in a graphical user interface (GUI) of the peripheral device (Casey, column 4, lines 1-5).

Referring to claim 41, Casey discloses that the peripheral device is a scanner and the functionality is a copying functionality (column 2, lines 58-67).

Referring to claim 42, Casey discloses that the peripheral device is a digital camera and the functionality is image printing (column 2, lines 58-67).

Response to Arguments

5. Applicant's arguments concerning claims 1, 3, 5, 6 and 8-11 have been fully considered but they are not persuasive.

Casey does disclose using an adapter device but further teaches an embodiment, which does not use the adapter device. Casey points out that the devices, the printer and the scanner can be directly connected to each other for carrying out the same functionality (column 5, lines 16-21). Figure 1 further discloses a PC that is also connected to the printer device, with the direct connection disclosing a connection between devices and the PC.

Casey also further points out that the control panel, which serves as the graphical user interface can be implemented right onto the printer without the adapter device, thereby teaching that the user interface is integrated in the peripheral device.

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See column 4, lines 1-5. The section Casey clearly discloses that the control panel is integrated onto the printer and not the adapter device.

The devices being coupled via a network is interpreted as the devices being connected through a network, where as shown in Figure 1, the devices are connected through a network. The connection of the devices to the adapter device, also teaches that there is a connection between the devices and the network, and communication between the devices and the network, even if the adapter device is taken into consideration. An adapter device may be connected to this system, but regardless, even through the adapter device, communication does occur between the devices and connection does exist to the network and between the devices. There is no clear disclosure with the communication and connections being direct without any other components involved. Information related to the software components of both devices is retrieved from the network (column 3, lines 5-7).

6. Applicant's arguments, filed 5/22/06, with respect to the rejection(s) of claim(s) 24-28 and 30-42 in view of Casey have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Casey and Brockway, with Brockway teaching automatic detection and identification of peripheral devices in a client/server system.

Conclusion

7. Responses to this action should be submitted as per the options cited below: The United States Patent and Trademark Office requires most patent related

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correspondence to be: a) faxed to the Central Fax number (571-273-8300) b) hand carried or delivered to the Customer Service Window (located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), c) mailed to the mailing address set forth in 37 CFR 1.1 (e.g., P.O. Box 1450, Alexandria, VA 22313-1450), or d) transmitted to the Office using the Office's Electronic Filing System.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namitha Pillai whose telephone number is (571) 272-4054. The examiner can normally be reached on 8:30 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on (571) 272-4063.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Namitha Pillai
Assistant Examiner
Art Unit 2173
August 4, 2006



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